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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/777,159 | 02/13/2004 | Baychar | | 5097 |

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EXAMINER

MATZEK, MATTHEW D

ART UNIT PAPER NUMBER

1771

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,159

Applicant(s)

BAYCHAR,

Examiner

Matthew D. Matzek

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 10/13/05, 9/9/05, 2/22/05, 11/29/04, 8/19/04
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: IDS: 2/22/05, 11/29/04, 9/19/04. 2/13/04.

Response to Amendment

1. Applicant's Preliminary Amendment dated, 2/13/2004, has been fully considered and entered into the Record. Claims 1-8 have been canceled and claims 9-22 are active.

Specification

2. The use of a multitude of trademarks has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.
3. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of "material may be apertured", is directed to the material's capability of being apertured rather than the article's actual structure.
5. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 recites a "thermal nonwoven", but further support for what a "thermal nonwoven" has not been provided for in the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 9-12, 14-17 and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Baychar (US 2001/0009830).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

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- a. Baychar teaches a moisture transfer system including a waterproof/breathable moisture transfer system having an inner fabric layer, a foam layer and encapsulated outer layer (Abstract). The applied reference teaches an outer layer of fabric 70, a waterproof/breathable membrane 60, abutting a foam material 50, abutting a mesh layer 40 [0037, Figure 3]. The waterproof/breathable membrane layer 60, maybe eliminated if the foam layer has microencapsulation technology to adjust to temperature changes [0037]. The outer layer of fabric 70 maybe encapsulated to provide a waterproof covering for the fabric [0034]. Foam material 50 may be an open cell foam [0034] with reversible enhanced thermal properties [0039].
- b. Claim 10 is rejected as the nonwoven layer may have reversible thermal properties [0038]. Claim 12 is rejected as cotton may be used in the applied article [0036]. Claim 16 is rejected as the nonwoven may be apertured [0033].
7. Claim 14 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Broun et al (US 5,431,970).

Broun et al. teach a laminate material for protective bags comprising a hydrophilic inner layer, an open-cell foam middle layer and a hydrophobic outer layer (Abstract). Both the hydrophilic inner layer and the hydrophobic outer cover are porous (col. 2, lines 34-36). The outer layer may be treated to make it water repellant (col. 2, lines 46-52). The hydrophobic shell may be woven or nonwoven (col. 4, lines 59-63). The inner layer may be woven or nonwoven (col. 4, lines 11-14). The article of Broun et al. is silent as to the use of reversible enhanced thermal foam and the use of encapsulation as a means of

waterproofing the outer layer. Claim 16 is rejected as the inner layer is capable of being apertured.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9, 11-12, 15 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broun et al. (US 5,431,970) in view of Caldwell (US 5,876,792) in further view of Colvin et al. (US 5,637,389).

a. Broun et al. teach a laminate material for protective bags comprising a hydrophilic inner layer, an open-cell foam middle layer and a hydrophobic outer layer (Abstract). Both the hydrophilic inner layer and the hydrophobic outer cover are porous (col. 2, lines 34-36). The outer layer may be treated to make it water repellant (col. 2, lines 46-52). The hydrophobic shell may be woven or nonwoven (col. 4, lines 59-63). The inner layer may be woven or nonwoven (col. 4, lines 11-14). The article of Broun et al. is silent as to the use of reversible enhanced thermal foam, cotton as the outer layer and the use of encapsulation as a means of waterproofing the outer layer.

b. Caldwell teaches a method to apply a layer of polymer that encapsulates a fabric web and leaves the interstitial spaces open (Abstract). This treatment offers the web with water resistance, increased durability, and improved barrier qualities by combining the use of encapsulated fibers and filaments and a breathable or controlled pore size internal

coating with a controlled surface chemistry modification and the like. Such webs, fibers and fabrics can be used to prepare a wide variety of products including, but not limited to, carpets, specialized clothing, career apparel, bioengineered surfaces for diagnostic applications, and upholstery. By use of the present invention, webs, fibers and fabrics can be manufactured with a wide variety of desired physical characteristics (col. 5, lines 7-20). The fibers used in the porous web may include cotton fibers (col. 15, lines 35-39).

c. Since Broun et al. and Caldwell are from the same field of endeavor (i.e. waterproof/breathable fabrics), the purpose disclosed by Caldwell would have been recognized in the pertinent art of Broun et al.

d. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the outer layer of Broun et al. by encapsulating the fabric with the motivation providing the fabric layer with water resistance, while still being breathable. However Broun et al. and Caldwell still fail to teach the use of reversible thermal foam.

e. Colvin et al. teach a foam material with a plurality of microcapsules containing a phase change material dispersed throughout the foam such that the microcapsules are individually encapsulated in the foam and may contain phase change material such as paraffinic hydrocarbons (col. 2, lines 28-45). Fabric layers may be attached to both sides of the foam (col. 2, lines 65-67). The article of Colvin et al. may be incorporated in to packaging materials (col. 3, lines 1-3).

- f. Since Broun et al. and Colvin et al. are from the same field of endeavor (i.e. fabric backed foam for packaging), the purpose disclosed by Colvin et al. would have been recognized in the pertinent art of Broun et al.
 - g. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have made the foam layer of Broun et al. with the microencapsulated phase change materials motivated by the desire to reduce the temperature of the enclosed article when exposed to extreme temperatures (col. 1, lines 15-20 and 43-47, Broun et al.).
9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Broun et al. (US 5,431,970) in view of Caldwell (US 5,876,792) and in view of Colvin et al. (US 5,637,389) as applied above to claim 11 in further view of Hargrove (US 4,050,491). The applied art is silent as to the use of denim as the outer layer.
- a. Hargrove teaches the use of denim for as a protective cloth bag for supplies (col. 1, lines 26-30).
 - b. Since Broun et al. and Hargrove are from the same field of endeavor (i.e. protective bags), the purpose disclosed by Hargrove would have been recognized in the pertinent art of Broun et al.
 - c. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the bag of Broun et al. with the a denim outer layer motivated by the desire to make a more aesthetically pleasing article.
10. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broun et al. (US 5,431,970) in view of Zuckerman et al. (US 6,660,667).

- a. Broun et al. teach a laminate material for protective bags comprising a hydrophilic inner layer, an open-cell foam middle layer and a hydrophobic outer layer (Abstract). Both the hydrophilic inner layer and the hydrophobic outer cover are porous (col. 2, lines 34-36). The outer layer may be treated to make it water repellant (col. 2, lines 46-52). The hydrophobic shell may be woven or nonwoven (col. 4, lines 59-63). The inner layer may be woven or nonwoven (col. 4, lines 11-14). The article of Broun et al. is silent as to the use of the use of a knit material with reversible enhanced thermal properties as the inner layer.
- b. Zuckerman et al. teach a coating composition for fabric that comprises microspheres containing phase change material dispersed though out a polymeric binder (Abstract). The fabrics available for coating include knitted fabrics (col. 11, lines 49-55). The coating composition is designed to maintain all the breathability and flexibility of the coated fabric (col. 3, lines 64-67).
- c. Since Broun et al. and Zuckerman et al. are from the same field of endeavor (i.e. thermally dissipative fabrics), the purpose disclosed by Zuckerman et al. would have been recognized in the pertinent art of Broun et al.
- d. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have made the inner layer of Broun et al. with the microencapsulated phase change material coated knit fabric of Zuckerman et al. motivated by the desire to reduce the temperature of the enclosed article when exposed to extreme temperatures (col. 1, lines 15-20 and 43-47, Broun et al.).

Double Patenting

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 9-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,048,810. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to obvious variants of one another.

12. Claims 9-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 11, 14-16, 18, 27, 29-32, 34-36 and 38-61 of recently allowed Application 08/887,847. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to obvious variants of one another.

13. Claims 9-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20, 13-19 and 1-18 of copending Application Nos. 11/098,639; 10/987,162; 10/786,416, respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to obvious variants of one another.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

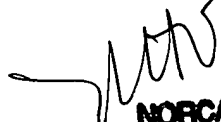
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Matzek whose telephone number is (571) 272-2423. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdm


NORCA TORRES
PRIMARY EXAMINER